RECORD AND BRIEFS

No. 15-1293

IN THE

Supreme Court of the United States

MICHELLE K. LEE, UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR, UNITED STATES PATENT AND TRADEMARK OFFICE,
Petitioner,

v.

SIMON SHIAO TAM,
Respondent,

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF FOR AMANDA BLACKHORSE, MARCUS BRIGGS-CLOUD, PHILLIP GOVER, JILLIAN PAPPAN AND COURTNEY TSOTIGH AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

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QUESTIONS PRESENTED

Section 2(a) of the Lanham Act provides that a mark is not eligible for federal registration if it "[c]onsists of or comprises . . . matter which may disparage . . . persons, living or dead . . . or bring them into contempt, or disrepute." 15 U.S.C. § 1052(a).

1. Does the disparagement provision of Section 2(a) violate the First Amendment?

2. Is the disparagement provision void for vagueness under the Due Process Clause?

3. Should the disparagement provision be interpreted according to its plain language?*

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* The Government's Petition for a Writ of Certiorari presented the first question. Respondent Simon Tam's Opposition raised the latter two questions.

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INTEREST OF THE *AMICI*[1]

Amici curiae Amanda Blackhorse, Marcus Briggs-Cloud, Phillip Gover, Jillian Pappan, and Courtney Tsotigh are Native American individuals who successfully petitioned the Trademark Trial and Appeal Board ("TTAB") to cancel six service mark registrations of the Washington NFL football team. The TTAB found that the team's marks were ineligible for registration under Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), and thus subject to cancellation, because they contain matter that may disparage Native Americans (*i.e.*, the term "redskin" or a derivation of "redskin"). *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080 (T.T.A.B. 2014).

The team's owner, Pro Football, Inc. ("PFI"), brought an action in the Eastern District of Virginia, under 15 U.S.C. § 1071(b), to overturn the TTAB's decision. The District Court granted summary judgment in favor of Blackhorse and the other *amici*, agreeing with the TTAB that PFI's marks were ineligible for registration. *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 467 (E.D. Va. 2015). The Court also rejected PFI's Constitutional arguments. *See id.* at 454-464.

PFI appealed and its appeal is pending. *Pro-Football, Inc. v. Blackhorse, appeal docketed*, No. 15-

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[1] Petitioner's letter consenting to the filing of this brief, and Respondent's letter consenting to the filing of *amicus* briefs, are on file with the Clerk's office. No party or counsel for a party has authored this brief in whole or in part, and no person or entity other than *amici* and their counsel has made a financial contribution to its preparation or submission.

1874 (4th Cir. Aug. 6, 2015). PFI petitioned this Court for a writ of certiorari before judgment, which was denied.

Amici have an interest in ensuring that the United States Patent and Trademark Office ("USPTO") properly implements Section 2(a) so that they can avoid further insult resulting from the registration of marks that disparage them and other Native Americans.

INTRODUCTION

A. Trademark And Service Mark Registration Process.

A "trademark" is a word, name, symbol or combination thereof, used in commerce to identify and distinguish the goods of one entity from those of others, while a "service mark" is used to distinguish services. 15 U.S.C. § 1127. The term "mark" is a general term that covers trademarks and service marks. *Id.* The mark at issue in this case is a service mark.

Rights in a mark arise from use of the mark in commerce, not due to any Government action. *B&B Hardware, Inc. v. Hargis Indus.*, 135 S. Ct. 1293, 1300 (2015). The Government does not grant or issue marks.

The Lanham Act, 15 U.S.C. §§ 1051 *et seq.*, creates a mechanism for a mark owner to seek a registration from the USPTO. This case does not concern the refusal of the USPTO to issue a mark

(which the Government does not issue) but rather its refusal to issue a mark *registration*.

USPTO Examining Attorneys review applications to determine whether the mark meets statutory and regulatory requirements for registration. 15 U.S.C. § 1051; 37 C.F.R. § 2.61. Section 2 of the Lanham Act provides that a mark is ineligible for registration if, among many other criteria, it contains or comprises matter that "may disparage" persons, institutions, beliefs or national symbols." 15 U.S.C. § 1052; *see also* 15 U.S.C. § 1053 (applying § 1052 to service marks).

If the Examining Attorney believes that the application satisfies the registration criteria, the USPTO publishes the application in the *Official Gazette*, a weekly USPTO periodical. 15 U.S.C. § 1062; 37 C.F.R. §§ 2.61 & 2.80. One who learns of the application from the *Official Gazette* may object by filing an opposition proceeding with the TTAB within 30 days of publication. 15 U.S.C. § 1063. The TTAB will then determine whether the USPTO should issue a registration despite the opposition. If there is no objection, and if the application satisfies the statutory and regulatory criteria, the USPTO will issue a registration certificate to the applicant and will list the mark on the Principal Register, the official record of all marks registered by the United States. 15 U.S.C. § 1057; 37 C.F.R. § 2.151.

On the other hand, if – as occurred with Respondent Simon Tam's application – an Examining Attorney refuses registration, the applicant may appeal the refusal to the TTAB. 15

U.S.C. § 1070. The TTAB will then decide whether the mark is entitled to registration.

B. The Owner Of An Unregistrable Mark Has Statutory And Common Law Enforcement Rights.

Unregistered marks – including unregistrable marks – are fully enforceable. The owner of an unregistrable mark can bring infringement claims for an injunction or damages under both Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and the common law.

The plain language of Section 43(a) permits enforcement against any person who "uses in commerce any word, term, name, symbol, device, or any combination thereof" that is likely to cause confusion or mistake regarding the source of that person's goods or services. 15 U.S.C. § 1125(a)(1)(A). There is nothing in Section 43(a) that limits these claims to registered or registrable marks.

Accordingly, courts have held that unregistrable marks are enforceable under Section 43(a). *See In re City of Houston*, 731 F.3d 1326, 1331 (Fed. Cir. 2013) (stating that a trademark ineligible for registration under Section 2(b) of the Lanham Act may be enforced under Section 43(a)), *cert. denied*, 134 S. Ct. 1325 (2014). In fact, courts have held that Section 43(a) provides for enforcement of titles of single literary works and trade names, neither of which is eligible for registration under the Lanham Act. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1163 n.2 (Fed. Cir. 2002) (single

book titles); *Sugar Busters LLC v. Brennan*, 177 F.3d 258, 269 (5th Cir. 1999) (same); *Accuride Int'l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1534 (9th Cir. 1989) (trade names).

The Federal Circuit's suggestion that unregistrable marks cannot be enforced under Section 43(a) is not well-founded. *See In re Tam*, 808 F.3d 1321, 1344 n.11 (Fed. Cir. 2015). It took out of context a statement by this Court that Section 43(a) protects "'qualifying unregistered trademarks'" and that "'the general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).'" *Id.* (quoting *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992)). In *Two Pesos*, this Court was merely stating that a mark eligible for registration will tend to have the source-identifying properties and hence be eligible for enforcement under Section 43(a). *Two Pesos* did not imply that unregistrable marks necessarily lack the source-identifying properties needed for Section 43 enforcement.

The Federal Circuit also doubted that Tam's mark was enforceable under common law. *See In re Tam*, 808 F.3d at 1344. There are, however, examples of enforcement under common law of trademarks comprising ethnic slurs. *See, e.g.*, *Leidersdorf v. Flint*, 7 N.W. 252 (Wis. 1880) ("Nigger-Hair Smoking Tobacco"); *McCann v. Anthony*, 21 Mo. App. 83, 91-92 (1886) ("Old Coon Smoking Tobacco").

SUMMARY OF ARGUMENT

1. The Federal Circuit erred in holding that the Lanham Act prohibition against registering marks that "may disparage" violates the First Amendment. *See In re Tam*, 808 F.3d at 1328. The refusal to register a mark does not implicate the First Amendment rights of the mark owner.

Trademark law grants a speech monopoly to mark owners, enabling the owner to silence others from using similar words or symbols. The USPTO's refusal to register Tam's mark may marginally reduce his ability to silence others, but that does not implicate – let alone violate – his right to Free Speech. There is no First Amendment right to curtail the speech of others.

There is no merit to Tam's argument that the disparagement provision violates the First Amendment because it involves viewpoint discrimination. If the Constitution prohibits viewpoint discrimination in the context of a mark registration, it is not the First Amendment that does so. Depending on the facts and circumstances presented, other Constitutional provisions, such as the Equal Protection, Due Process or Establishment Clause, might prevent the Government from discriminating based on content when it issues mark registrations. See *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 598 n.3 (1998) (Scalia, J., concurring); *Pleasant Grove City v. Summum*, 555 U.S. 460, 481-82 (2009) (Stevens, J., concurring). The right to silence others, however, is not a right that arises under the First Amendment. Therefore,

marginally reducing that right on alleged viewpoint-discriminatory grounds does not violate the First Amendment.

Even if this Court were to entertain the notion that First Amendment rights are implicated by a law that reduces a speech-monopolist's ability to silence others, the refusal to register a mark is not significant enough to burden the mark owner's Free Speech rights. Denial of a registration does not render a mark unenforceable. Unregistrable marks can be enforced under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and under the common law. The Federal Circuit erred in concluding otherwise, causing it to overstate significantly the impact of a registration denial.

2. Alternatively, due to the Government speech doctrine, the refusal to register Tam's mark did not violate his First Amendment rights. *See Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2246 (2015). Although a private party's use of a mark is not Government speech, the issuance of a registration and the publication on the USPTO's Principal Register are Government speech. Reprinted below are Government registrations of blatantly racist trademarks registered before Congress amended the Lanham Act to preclude registration of marks that "may disparage." *Infra* at 21-22. The First Amendment does not compel the Government to issue registration certificates for such marks or publish those marks on its Principal Register. Congress made a valid decision that the Government should not associate itself with such marks.

3. The disparagement provision of Section 2(a) is not void for vagueness under the Due Process Clause. Section 2(a) imposes no criminal or civil penalties and proscribes no conduct. As a result, it is reviewed deferentially for vagueness.

The term "may disparage" contains commonly understood words, and this Court even employed "disparage" to articulate the test for permissible legislative prayer under the Establishment Clause. *Marsh v. Chambers*, 463 U.S. 783 (1983). Section 2(a) also does not encourage and authorize arbitrary and discriminatory enforcement. The Lanham Act and USPTO regulations create a transparent and fair process for evaluating registration applications.

4. The disparagement provision of Section 2(a) should be interpreted according to its plain language. Both the plain language of the Lanham Act and its legislative history demonstrate that a mark is not eligible for registration if it "may disparage." Proof of actual disparagement is not required. Likewise, under the plain language of Section 2(a), proof that the mark owner intended to disparage is not required for the mark to be ineligible for registration.

When the TTAB applies the disparagement provision of Section 2(a), it looks for evidence that a "substantial composite" of the referenced group (here, people of Asian descent) find that a mark is disparaging. While evidence of the views of a "substantial composite" is one way of demonstrating that a mark "may disparage," it is not the only way. This Court should not imply that the TTAB's

"substantial composite" test is the only way to demonstrate that a mark "may disparage."

ARGUMENT

I. THE DISPARAGEMENT PROVISION DOES NOT VIOLATE THE FIRST AMENDMENT.

A. Tam's First Amendment Rights Were Not Affected.

1. Refusal To Register A Mark May Affect The Owner's Ability To Enjoin Others From Speaking, But The Right To Silence Others Is Not A First Amendment Right.

a. The Federal Circuit erred in treating the refusal to issue a service mark registration as burdening Tam's First Amendment rights. *In re Tam*, 808 F.3d at 1345.

The Federal Circuit's position turns trademark law on its head. Trademark law is not a device to protect the First Amendment rights of the mark owner, but to decrease the speech rights of everyone else. Trademark law grants a mark owner a speech monopoly. *See George Nelson Found. v. Modernica*, 12 F. Supp. 3d 635, 644-45 (S.D.N.Y. 2014) ("'The user who first appropriates the mark obtains [an] enforceable right to exclude others . . . .'") (citation omitted). The law empowers the owner to enjoin others from using similar words and symbols.

When the USPTO refuses to issue (or cancels) a registration, that action might marginally affect the owner's ability to enjoin others from speaking, but there is no First Amendment right to prevent others from speaking. Trademark law – and the mark registration process – do not exist to advance the First Amendment, but *despite* the First Amendment.

Every trademark or service mark injunction involves enforcing a speech monopoly on behalf of the mark owner and silencing others who wish to use similar words or symbols. *See, e.g., San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522 (1987) (affirming injunction barring a group from using the words "Gay Olympic Games"); *Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 772, 778-79 (8th Cir. 1994) (enjoining use of "Michelob Oily" by party commenting on oil spill in river supplying water to Anheuser-Busch brewery); *Hershey's Co. v. Art Van Furniture, Inc.*, 2008 WL 4724756 (E.D. Mich. Oct. 24, 2008) (enjoining furniture company from using a design of a brown sofa emerging from a wrapper on its web site because the image resembled a Hershey's bar).

As a result, "the primary cost of recognizing property rights in trademarks is the removal of words from (or perhaps non-entrance into) our language." *Brother Records, Inc. v. Jardine*, 318 F.3d 900, 906 (9th Cir. 2003) (quotation omitted).

Even if a member of the public is able to defeat a mark owner's enforcement action, "social and commercial discourse" can be chilled or even

rendered "impossible" by the mere threat of an infringement lawsuit. *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 307 (9th Cir. 1992). And it can require extensive litigation for a member of the public to vindicate his or her right to free speech when a trademark owner wishes to exercise its monopoly speech power. *See Radiance Found., Inc. v. NAACP*, 25 F. Supp. 3d 865, 901-02 (E.D. Va. 2014) (enjoining organization from calling the NAACP the "National Association for the Abortion of Colored Persons" in protest over the NAACP's collaboration with Planned Parenthood), *rev'd*, 786 F.3d 316 (4th Cir. 2015) (reversing only after ACLU provided *pro bono* assistance with appeal); *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, 736 F.3d 198, 200-02 (2d Cir. 2013) (affirming coffee shop's right to use the term "Charbucks" despite opposition by Starbucks, but only after a trial and three appeals).

This Court has recognized that marks restrict the public's ability to speak, but has held that such a restriction can be justified when it advances a substantial Government interest. *See San Francisco Arts*, 483 U.S. at 536-39 (holding that enforcement of trademark satisfied *Central Hudson* standard for commercial speech restriction). Even when justified, the enforcement of marks represents a restriction on the ability of the public to speak. *See* Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After* Eldred, 44 Liquormart, and Bartnicki, 40 Hous. L. Rev. 697, 698 (2003) (characterizing copyright law and trademark law as "speech restrictions").

Although the ACLU paradoxically has argued that Section 2(a) is unconstitutional, it agrees that cancelling a registration results in reducing the mark owner's ability to silence others, thereby increasing the legal rights of the public to speak:

> Furthermore, cancelling the Washington team's trademark may not even be effective, because cancelling a trademark doesn't prevent the team from using it. *It does, however, make it easier for other people to disseminate it. So the Trademark Office decision in this case might result in even more use of a distasteful term – not less.*

Esha Bandari, *'You're Not Wrong, You're Just an A**hole,'* ACLU Blog of Rights (Mar. 6, 2015, 12:30 PM), https://www.aclu.org/blog/free-speech/youre-not-wrong-youre-just-ahole (emphasis added). But making it "easier for other people" to use words and symbols, *i.e.*, freeing them of the need to obtain a license from a mark owner, means that more speech would be legally permitted by cancelling the registrations. The First Amendment is not violated when more speech is legally permitted.

b. Some have argued that the First Amendment problem with the disparagement provision is that it discriminates based on the alleged viewpoint expressed in the mark. They point out that a mark that "may disparage" Asian Americans (or Native Americans) is not eligible for registration while non-disparaging marks are eligible. And, they ask, how about a law that

discriminates based on a political position expressed in a mark? Would it be constitutional for Congress to permit registration of "Vote Democratic" brand ice cream but not "Vote Republican" brand ice cream?

If the Constitution prohibits viewpoint discrimination in the context of a mark registration, it is not the First Amendment that does so. Depending on the facts and circumstances presented, other Constitutional provisions, such as the Equal Protection, Due Process or Establishment Clause, might prevent the Government from discriminating based on content when it issues mark registrations. See *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 598 n.3 (1998) (Scalia, J., concurring) (stating that while the Constitution would prevent the Government from acting to promote Republican candidates, that "unconstitutionality has [nothing] to do with the First Amendment"); *Pleasant Grove City v. Summum*, 555 U.S. 460, 481-82 (2009) (Stevens, J., concurring) (stating that the Equal Protection Clause and, in some instances, the Establishment Clause – but not the speech provisions of the First Amendment – preclude the Government from expressing offensive or partisan messages).

As explained above, however, the right to silence others is not a right that arises under the First Amendment. Therefore, marginally reducing that right on alleged viewpoint-discriminatory grounds does not violate the First Amendment. This point is illustrated by a copyright case, *Golan v. Holder*, 132 S. Ct. 873 (2012).

In *Golan*, publishers, orchestra conductors, musicians and others argued that their First Amendment rights were violated by a law that re-extended copyright protection over works that had previously entered the public domain. The law prevented them from disseminating written works or playing music as they wished. *Id.* at 878. The Court affirmed the law, but suggested that their First Amendment rights might be violated if "copyright protection . . . hinge[d] on the author's viewpoint." *Id.* at 892. In other words, if a publisher's ability to disseminate a written work depended on the viewpoint expressed by the work, then the *publisher's* First Amendment rights might be violated. That is, viewpoint discrimination in copyright may infringe on *non-copyright holders'* First Amendment rights. The Court, however, did not suggest that the *copyright holder's* First Amendment rights would be implicated. This is because the right to enforce a copyright (and silence others), like the right to enforce a trademark, is not a right that arises under the First Amendment. *See id.* at 889 ("some restriction on expression is the inherent and intended effect of every grant of copyright").[2]

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[2] As discussed above with marks, an author might have an Equal Protection, Due Process or Establishment Clause claim if he or she were denied a copyright registration due to the content or viewpoint expressed in the author's work. Further, Congress's power to enact copyright laws is subject to the Copyright Clause, which gives Congress the power to "promote the Progress of Science . . . by securing for limited Times to Authors . . . the exclusive right" to their writings. U.S. Const., art. 1, § 8, cl. 8. The law is unsettled whether the Copyright

Tam's case differs from a scenario in which a burden on *speech* is imposed, such as if a city refused to plow the snow in front of a home with a "Vote Republican" sign but would plow if the sign said "Vote Democratic." In the snow-plowing case, the city is unquestionably burdening speech based on content. By contrast, when the Lanham Act provides that marks containing certain matter are unregistrable, speech is not burdened, but *the power to silence others* is burdened.

2. Many Federal Trademark And Similar Laws Discriminate On The Basis Of Content And Would Fall If The Disparagement Provision Is Held Unconstitutional.

The argument advanced above – that the First Amendment does not protect the right of a speech-monopolist to enjoin others from speaking – provides a narrow, coherent basis for decision. A ruling on this basis will create no tension with any prior decision of this Court and will have no impact on overall First Amendment jurisprudence.

Clause requires or prohibits content-based discrimination, due to uncertainty in how to interpret the Clause's language "to promote the Progress of Science." *Compare Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 856 (5th Cir. 1979) (stating that the Copyright Clause does not permit content-based discrimination) *with* 41 U.S. Op. Atty. Gen. 395 (U.S.A.G. Dec. 18, 1958) ("It has been generally accepted for years that seditious, libellous, obscene or immoral works are not entitled to copyright. . . . Judicial authority has been found to support this view; none has been found to the contrary.").

On the other hand, if the disparagement provision violates the First Amendment, then many other statutes do as well. For instance, the Section 2(a) provision against registering marks with "scandalous" or "immoral" matter would violate the First Amendment because it is a content-based provision. 15 U.S.C. § 1052(a); *see In re Tam*, 808 F.3d at 1330 n.1.

Similarly, if the disparagement provision violates the First Amendment, then so, too, do dozens of statutes giving special trademark-style protections to certain patriotic organizations. *See The Last Best Beef, LLC v. Dudas*, 506 F.3d 333, 339-40 (4th Cir. 2007) ("Congress has often removed specific trademarks from the general trademark application process."). These laws give the favored organizations the "exclusive right to use" the organization's name, and frequently its emblems, symbols, seals, and badges – and sometimes even the "words and phrases" that the organization uses, as is the case for Boy Scouts, Girl Scouts and Civil Air Patrol. 36 U.S.C. §§ 30905, 40306 & 80305.

These laws give the power to enjoin similar third-party uses without the need to show likelihood of consumer confusion and render them invulnerable to normal trademark defenses. *See San Francisco Arts*, 483 U.S. at 530-31 (holding that U.S. Olympic Committee did not need to prove likelihood of confusion and that "traditional trademark defenses" did not apply); *Wrenn v. Boy Scouts of Am.*, 2008 WL 4792683, at *4 n.3 (N.D. Cal. Oct. 28, 2008) (stating that Boy Scouts did not need to prove likelihood of confusion). "Many of the patriotic or fraternal

organizations chartered by Congress receive exclusive rights to words or phrases which may be enforced without regard to the normal standards of trademark law." *Am. Legion v. Matthew*, 144 F.3d 498, 499 (7th Cir. 1998).

The statutes award the special protections as a means of advancing the patriotic, pro-military or other laudable purposes of the organization. *See San Francisco Arts*, 483 U.S. at 537-38 & n.17 (stating that Congress provided special protections to the U.S. Olympic Committee to advance the statutory purposes of the organization). For example, one statute gives to Future Farmers of America (whose statutory purposes include to "train for useful citizenship, and foster patriotism") the exclusive right over its name, seals, emblems and badges. 36 U.S.C. §§ 70902, 70907. Other examples include:

- American Legion, *id.* §§ 21702, 21705.
- Ladies of the Grand Army of the Republic, *id.* §§ 130102, 130106.
- Little League, *id.* §§ 130502, 130506.
- United Service Organizations, Incorporated or USO, *id.* §§ 220102, 220106.
- Veterans of Foreign Wars of the United States, *id.* §§ 230102, 230105

There are many other such statutes. 36 U.S.C. §§ 20907, 21904, 22306, 22505, 22706, 30106, 30306, 30507, 30706, 40306, 50305, 70506, 140304, 150707, 152306, 152506, 152907, 153104, 153506, 153706, 154106, 154707, 170105, 170307, 190106, 190307, 200306, 220306.

If the disparagement provision of Section 2(a) is unconstitutional because it discriminates based on the content of the trademark, then these special protection laws – which discriminate based on the patriotic, pro-military or virtuous mission of the organization – are also unconstitutional.

3. Unregistrable Marks Are Enforceable. Their Owners Are Fully Capable Of Silencing Others.

Even if First Amendment rights are implicated by a law that reduces a speech-monopolist's ability to silence others, the refusal to register a mark is not significant enough to burden the mark owner's First Amendment right to free speech.

As explained above, an unregistrable mark is enforceable under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and under the common law. *See supra* at 4. Mark owners can obtain injunctions and damages for infringement. They can call upon the courts to bar others from using the words and symbols that they wish to use.

The fact that unregistrable marks are enforceable significantly distinguishes mark registration from copyright registration. A copyright infringement action cannot be brought unless the work has been registered with the Copyright Office. *See* 17 U.S.C. § 411(a); *Reed Elsevier, Inc. v. Muchnik*, 559 U.S. 154, 158 (2010). Thus, the refusal to issue a copyright registration has a far greater impact than the refusal to register a mark.

Furthermore, while the benefits of registration can be "substantial," *B&B Hardware, Inc.*, 135 S. Ct. at 1300, the benefits vary considerably from one mark to another. It is not possible to generalize. For example, the evidentiary presumptions that come with registration (*i.e.*, presumptions of validity, ownership, and exclusive right to use the mark) provide no added value to owners of well-established marks (*e.g.*, "Washington Redskins") because those evidentiary points cannot be reasonably disputed.

B. Refusing To Register A Mark Is An Example Of Government Speech.

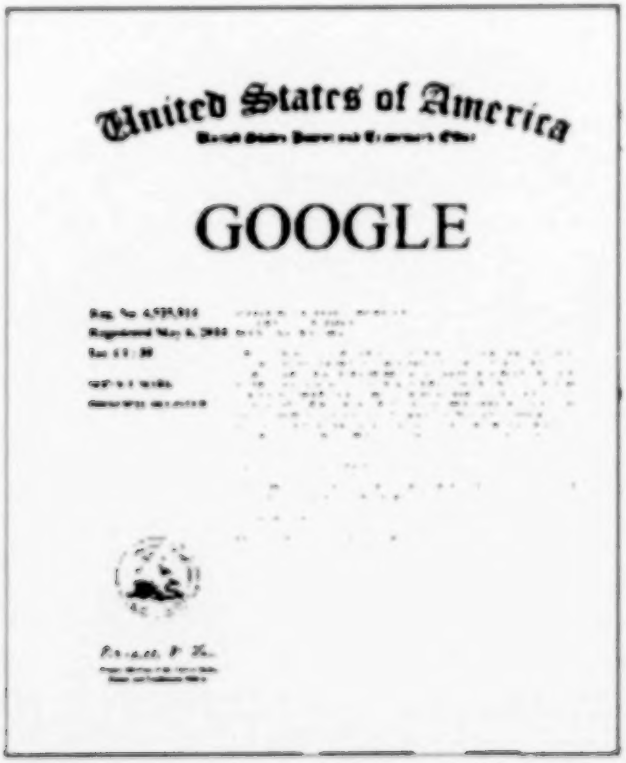
The USPTO's refusal to register Tam's mark fits within the Government speech doctrine and therefore does not implicate the Free Speech Clause. As this Court explained, "[w]hen [the] government speaks, it is not barred by the Free Speech Clause from determining the content of what it says." *Walker*, 135 S. Ct. at 2245; *see also Johanns v. Livestock Mktg. Assn.*, 544 U.S. 550, 553 (2005).

"The Free Speech Clause restricts government's regulation of private speech; it does not regulate government speech." *Pleasant Grove City, Utah*, 555 U.S. at 467. "[G]overnment statements (and government actions and programs that take the form of speech) do not normally trigger the First Amendment rules designed to protect the marketplace of ideas." *Walker*, 135 S. Ct. at 2245-46. Because the Government "is entitled to promote a program, to espouse a policy, or to take a position," the Government can discriminate between

viewpoints when it engages in Government speech. *Id.* at 2246.

1. A USPTO Registration Certificate And The Principal Register Are Government Documents.

The Lanham Act requires that a registration certificate be issued "in the name of the United States of America," "under the seal of the USPTO," and that it be "signed by the Director." 15 U.S.C. § 1057(a). The statute further requires that the registration certificate "shall reproduce the mark" and "state that the mark is registered on the principal register." *Id.* An image of a registration certificate is below:


United States of America

GOOGLE

If this Court rules that Section 2(a) of the Lanham Act is unconstitutional, the USPTO would have to issue registration certificates with ugly racist images. The following are examples of racist marks registered before enactment of the prohibition against registering disparaging marks.

Amicus Brief for Blackhorse, et. al. at 40-73, *In re Tam*, No. 14-1203 (Fed. Cir. July 23, 2015), ECF No. 148.

The Free Speech Clause does not obligate the Government to issue registration certificates displaying such hateful words and symbols, or publish them in its Principal Register.

2. Trademark Registrations Are Government Speech.

In *Walker*, this Court upheld Texas's refusal to issue specialty license plates featuring the Confederate battle flag. 135 S. Ct. 2239. A Texas statute provided that the State could refuse to create a specialty plate "if the design might be offensive to any member of the public." *Id.* at 2244-45. A refusal to issue a possibly offensive specialty license plate was an exercise of Government speech not subject to challenge on Free Speech Clause grounds. *Id.* at 2246, 2252-53.

In *Walker*, the Court found three factors important, each of which weighs in favor of a finding of Government speech here.

First, state governments have historically communicated messages through license plates. *Id.* at 2248. Here, too, a registration is a means by which the USPTO communicates to the public. The USPTO uses a registration certificate and the Principal Register to inform the public of the validity of the mark, the identity of the owner, and the owner's exclusive right to use the mark, subject to any limitations that the USPTO also communicates via the registration certificate. 15 U.S.C. § 1057(b). Although the Government does not communicate messages through the mark itself, it does communicate messages through the registration of the mark. That is the relevant inquiry because Tam was refused a registration, not a mark.

Second, the Court noted that the public associates messages on license plates with the Government, in part because the name of the issuing state is a part of every plate. *Walker*, 135 S. Ct. at 2248. Likewise, a registration certificate and the Principal Register are Government documents. Indeed, when parties seek to oppose or cancel the registration of another party's trademark, they must petition the TTAB for the obvious reason that a registration certificate is a Government communication and the Principal Register is a Government database.

Third, the Court relied on the fact that the state had "effectively controlled" the messages it conveyed by having "final approval authority" over the messages. *Id.* at 2249. Likewise, here, Congress established criteria over registrability and delegated responsibility for the registration program to the USPTO.[3]

Another relevant consideration is whether the Government's speech occurs in the context of a traditional Governmental function. Here, the USPTO issues registrations to advance traditional governmental functions – consumer protection and the protection of private property. *Park 'N Fly v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 207 (1985).

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[3] The fact that Congress set expressive criteria in Section 2(a) distinguishes this case from the routine issuance of permits and licenses, contrary to the Federal Circuit's concern. *See In re Tam*, 808 F.3d at 1347-48.

The Federal Circuit found that the refusal to issue Tam's mark did not fall under the rubric of the Government speech doctrine, because the Lanham Act allows many tawdry and unsavory marks to be registered, marks expressing messages that the Government surely does not endorse. *In re Tam*, 808 F.3d at 1346-47. This argument is foreclosed by *Walker*. In *Walker*, the Court rejected the argument that, because Texas could not possibly be endorsing some of the messages on approved plates, the rejection of a specialty plate design did not satisfy Government speech. *See Walker*, 135 S. Ct. at 2255 (Alito, J., dissenting). Indeed, inconsistency in Government messaging is unsurprising. Politics and governance in a democracy involves compromises, balancing competing interests, and a great deal of human imperfection. The fact that the Government's messages may be mixed, or subject to criticism as hypocritical, incomprehensible or contradictory, does not make the speech any less Government speech.

II. THE DISPARAGEMENT PROVISION IS NOT VOID FOR VAGUENESS.

A. The Standard Of Review Is Lenient Because Section 2(a) Of The Lanham Act Does Not Make Any Conduct Unlawful.

The doctrine that a statute can be void for vagueness "is an outgrowth not of the First Amendment, but of the Due Process Clause of the Fifth Amendment." *United States v. Williams*, 553 U.S. 285, 304 (2008). The doctrine ensures that imprisonment or criminal or civil fines are not imposed based on the violation of an unduly vague law or regulation. *See, e.g., id.* at 304; *Grayned v. City of Rockford*, 408 U.S. 104, 108-09 (1972) (void-for-vagueness doctrine ensures that statutes and regulations give a "person of ordinary intelligence a reasonable opportunity to know what is *prohibited*, so that he may act accordingly") (emphasis added).

Section 2(a) of the Lanham Act, however, prohibits no conduct or speech. It imposes no criminal sanction or civil penalties. It is impossible to "violate" Section 2(a).

A greater degree of vagueness is therefore tolerated by the Constitution: "The degree of vagueness that the Constitution tolerates – as well as the relative importance of fair notice and fair enforcement – depends in part on the nature of the enactment." *Hoffman Estates v. The Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 498 (1982); *see also F.T.C. v. Wyndham Worldwide Corp.*, 799 F.3d 236, 249 (3d Cir. 2015) ("The level of required notice

for a person to be subject to liability varies by circumstance."). Economic regulation is "subject to a less strict vagueness test." *Hoffman Estates*, 455 U.S. at 498. Further, "[t]he Court has also expressed greater tolerance of enactments with civil, rather than criminal, penalties because the consequences of imprecision are qualitatively less severe." *Id.* at 498-99; *see also Finley*, 524 U.S. at 589 (stating that criminal statutes are subject to more stringent void-for-vagueness review).

While statutes and regulations that impose civil penalties on speech merit careful review because of their potential chilling effect, *see FCC v. Fox TV Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012), where the statute in question does not threaten speech with criminal or civil penalties, the scrutiny is relaxed. *See Finley*, 524 U.S. at 589 (applying a relaxed vagueness standard to review a statute setting criteria for NEA grants even though, "as a practical matter . . . artists may conform their speech to what they believe to be the decisionmaking criteria in order to acquire funding").

Because of the "nature of the enactment," Section 2(a) is entitled to lenient scrutiny under the void-for-vagueness doctrine. *Hoffman Estates*, 455 U.S. at 498.

B. The Term "May Disparage" Is Not Unconstitutionally Vague.

To be void for vagueness, a statute must "fail to provide the kind of notice that will enable ordinary people to understand what conduct it

prohibits . . . [or] authorize and even encourage arbitrary and discriminatory enforcement" by Government officials. *City of Chicago v. Morales*, 527 U.S. 41, 56 (1999). Neither concern applies here.

1. The Disparagement Provision Gives Fair Warning.

Although a statute must give "people of ordinary intelligence a reasonable opportunity to understand what conduct it prohibits,"[4] *Hill v. Colorado*, 530 U.S. 703, 732 (2000), the Due Process Clause does not require "perfect clarity and precise guidance." *Ward v. Rock Against Racism*, 491 U.S. 781, 794 (1989). Because we are "[c]ondemned to the use of words, we can never expect mathematical certainty from our language." *Grayned*, 408 U.S. at 110. Courts should look to "[d]ictionary definitions and old-fashioned common sense" in evaluating whether a statutory term is unduly vague. *Wag More Dogs, LLC v. Cozart*, 680 F.3d 359, 371 (4th Cir. 2012).

Dictionaries contemporaneous with the 1946 enactment of the disparagement provision of Section 2(a) contained consistent definitions of "disparage" as meaning "to dishonor by comparison with what is inferior," "to speak slightingly of," "to deprecate," to "undervalue," "to regard or speak of slightingly," "to affect or injure by unjust comparison . . . ." *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, at *35 (T.T.A.B. 1999) (quoting *Webster's New International Dictionary*, G. & C. Merriam Company (2nd ed.

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[4] As noted, Section 2(a) does not "prohibit" any conduct.

1947) and *New "Standard" Dictionary of the English Language, Funk and Wagnalls Company* (1947)). From these definitions, the TTAB stated that to determine whether a trademark contains matter that "may disparage," it must determine whether the matter "may dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison." *Id.*[5]

This Court's use of "disparage" in *Marsh v. Chambers*, 463 U.S. 783 (1983), further demonstrates that "disparage" is not unconstitutionally vague. In *Marsh*, the Court employed "disparage" when it formulated the test under the Establishment Clause for the scope of permitted prayer to begin a legislative session: "The content of the prayer is not of concern to judges where, as here, there is no indication that the prayer opportunity has been exploited to proselytize or advance any one, *or to disparage any other*, faith or belief." *Id.* at 794-95 (emphasis added); *see also Town of Greece v. Galloway*, 134 S. Ct. 1811, 1823-24 (2014) (applying *Marsh* disparagement test); *Rubin v. City of Lancaster*, 710 F.3d 1087 (9th Cir. 2013) (permitting legislative prayer because it did "not proselytize, or advance or disparage (*Marsh's* language)" a particular faith); *Simpson v. Chesterfield Cty. Bd. of Supervisors*, 404 F.3d 276,

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[5] PFI agrees that, when the Lanham Act was enacted, multiple dictionaries contained "materially identical definitions of 'disparage.'" Memorandum in Support of Motion for Summary Judgment on Constitutional Claims at 19 n.14, *Pro-Football, Inc. v. Blackhorse*, No. 14-cv-01043 (E.D. Va. Feb. 23, 2015), ECF No. 56.

284 (4th Cir. 2005) (upholding ordinance adopting *Marsh* disparagement language).

The First Circuit has also observed that "words like 'demean' or 'disparage' have reasonably clear meanings." *Ridley v. Massachusetts Bay Transp. Auth.*, 390 F.3d 65, 95 (1st Cir. 2004) (holding that guidelines prohibiting bus advertisements that "disparage" individuals or groups were not void for vagueness).

Further, the inclusion of the word "may" in front of "disparage" reduces any potential vagueness. The insertion of "may" gives notice that a trademark is not eligible for registration if there is some evidence of its disparaging character. Thus, it is not necessary to gather and weigh all relevant evidence to determine whether a mark is ineligible for registration; one need only check if there is enough evidence to find that a mark "may" disparage. *See, e.g.*, *Blackhorse*, 111 U.S.P.Q.2d at *29 (once evidence has been adduced that a trademark contains matter that may disparage, "the mere existence of differing opinions cannot change the conclusion").

Finally, "may disparage" is less vague than other terms that have been upheld in vagueness challenges. For example, in *National Endowment for the Arts v. Finley*, the Court reviewed a statute directing the NEA to fund works of art based on "artistic excellence and artistic merit . . . taking into consideration general standards of decency and respect for the diverse beliefs and values of the American public." *Finley*, 524 U.S. at 572, 589.

Although this language was "undeniably opaque," it was not void for vagueness. *Id.* at 576, 584, 588.

2. The Disparagement Provision Does Not Authorize Arbitrary And Discriminatory Enforcement.

It is not clear that the "arbitrary and discriminatory *enforcement*" prong of the vagueness test should apply; Section 2(a) is a not a statute that is "enforced" as it prohibits no conduct or speech. If it does apply, then it should be applied under a lenient review standard, as discussed above.

In any event, the Lanham Act and USPTO regulations ensure that decisions are made in an evenhanded and transparent way – they do not "authorize" or "encourage" "arbitrary and discriminatory" enforcement. Examining Attorneys are lawyers whose decisions approving or refusing trademark registrations are set forth in written letters that state the reasons for the decision. Those letters are published on the USPTO web site and can be reviewed by the public. *See* TRADEMARK MANUAL OF EXAMINING PROCEDURE ("T.M.E.P." or "Manual") §§ 108.01, 705. Likewise, TTAB Administrative Trademark Judges who review Examining Attorney decisions act in a public manner with controls that prevent arbitrary and discriminatory action. The TTAB consists of the Director and Deputy Director of the USPTO, the Commissioner for Patents, the Commissioner of Trademarks and Administrative Trademark Judges appointed by the Secretary of Commerce in consultation with the Director. 15 U.S.C. § 1067(b). The members of the TTAB are

publicly known. The TTAB sits in three-member panels when it reviews Examining Attorney decisions. 37 C.F.R. §§ 2.129(a) & 2.142(e)(1). TTAB decisions are written and published, identify the Judges who served on the panel, and are available for review and discussion by the public.

The Manual articulates the standard that Examining Attorneys will apply in determining whether a trademark contains matter that "may disparage," including whether matter "may be disparaging to a substantial composite of the referenced group." T.M.E.P. § 1203.03(b)(i). The Manual explains further that disparagement is considered in relation to the goods and services at issue. *Id.* It explains that intent is not a factor in the analysis. *Id.* And it contains citations to the holdings of numerous cases explaining where disparagement was found, where it was not found, and why. *Id.* § 1203.03(b)(ii).

Tam has argued that the disparagement provision of Section 2(a) is void for vagueness because there are multiple examples in which different Examining Attorneys came to different conclusions as to whether trademarks with similar matter may disparage.[6] But focusing only on inconsistent Examining Attorney decisions is to focus on a biased sample. It ignores all the consistent decisions of Examining Attorneys. Thus, while Tam and his supporting *amici* will likely be able to find seemingly inconsistent Examining

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[6] Brief for Respondent in Opposition to a Writ of Certiorari at 31.

Attorney decisions, their disparagement examples will be cherry-picked and will not reflect a systematic, empirical inquiry.

It is unavoidable – and not unconstitutional – that determinations by frontline Government employees, like USPTO Examining Attorneys, will not always be consistent. *See United States v. Mead*, 533 U.S. 218, 224, 233-34 (2001). The USPTO examines more than 300,000 registration applications each year. Brief for the Petitioner at 51.

Furthermore, examples of inconsistent Examining Attorney decisions do not equate "arbitrary and discriminatory" enforcement by the USPTO, since every applicant whose application was refused had the right to appeal to the TTAB. *See* 15 U.S.C. § 1070. And Tam will not be able to find two TTAB decisions that reach different outcomes over whether trademarks with the same matter "may disparage."[7]

Any seemingly inconsistent Examining Attorney decisions are also not relevant to determining whether Section 2(a) is vague when applied to "slants." This Court has stated that whether a statute is void for vagueness is a case-

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[7] In *In re Squaw Valley Dev. Corp.*, 80 U.S.P.Q.2d 1264 (T.T.A.B. 2006), the TTAB found that certain trademarks for clothing that contained "squaw" were disparaging to Native American women, but explained that a trademark containing "squaw" for ski equipment was not disparaging because, in connection with those goods, the likely meaning was a shorthand reference to the Squaw Valley, California ski area rather than to Native American women.

specific inquiry that depends on the specific facts presented. "We consider whether a statute is vague as applied to the particular facts at issue, for '[a] plaintiff who engages in some conduct that is clearly proscribed cannot complain of the vagueness of the law as applied to the conduct of others.'" *Holder v. Humanitarian Law Project*, 561 U.S. 1, 18-19 (2010) (quoting *Hoffman Estates*, 455 U.S. at 495). The question whether Section 2(a) is unduly vague when applied to "slants" is different from whether it is unduly vague when applied to "n*ggers" or to "redskins" or to some other term.[8]

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[8] In *Johnson v. United States*, 135 S. Ct. 2551 (2015), the Court entertained a facial challenge to the Armed Career Criminal Act, which enlarged criminal sentences by at least five years for defendants previously convicted of three violent felonies. The Court held that the residual clause of the statutory definition of "violent felony" was void for vagueness, even though there were some crimes that would surely fall within the residual clause. In *Johnson*, whether a prior crime fit within the residual clause did not require courts to examine whether the facts of the prior crime involved violent conduct, but whether in the "ordinary case," the crime in question involved conduct that poses a serious potential risk of physical injury. *Id.* at 2557; *see also Welch v. United States*, 136 S. Ct. 1257, 1262 (2016). Contrary to the statute in *Johnson*, Section 2(a) does not turn on analyzing imponderable abstractions, but on the "particular facts" of the trademark at issue. *Humanitarian Law Project*, 561 U.S. at 18-19. These facts will necessarily vary from one trademark to another. *See, e.g.*, *Blackhorse*, 112 F. Supp. 3d at 472-88 (reviewing the facts establishing that "redskins" may disparage Native Americans, facts that are not relevant to other trademarks). For this reason and because of the lenient standard applicable to non-punitive statutes, Section 2(a)—unlike the statute in *Johnson*—is not amenable to a facial challenge for vagueness.

III. SECTION 2(A) SHOULD BE INTERPRETED ACCORDING TO ITS PLAIN MEANING.

A. The Inclusion Of "May" In "May Disparage" Means That Proof Of Actual Disparagement Is Not Required For A Mark To Be Unregistrable.

We agree with Tam that the disparagement provision should be interpreted according to its plain meaning. Brief for Respondent in Opposition to a Writ of Certiorari at 14-16. But Tam overlooks the word "may." *Id.* at 16 ("The statute just says 'disparage.'").

In fact, a mark is unregistrable if it comprises "matter which *may* disparage" persons. 15 U.S.C. § 1052(a) (emphasis added). Congress's insertion of "may" before "disparage" was deliberate. The multiple other bars to registration in 15 U.S.C. § 1052 conspicuously lack "may." For example, to refuse registration of an immoral, deceptive, or scandalous mark, the statute requires that the mark contain matter that *actually is* "immoral, deceptive, or scandalous." 15 U.S.C. § 1052(a). The contrast is plain and significant. *See In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, at *2 (T.T.A.B. 2010) ("The structure of Section 2(a), with various refusals and, therefore, different tests, interwoven into its various parts, is the result of its legislative development.").

The drafting history also demonstrates that Congress deliberately inserted "may" before "disparage." Initial House and Senate bills provided

that a trademark is ineligible for registration if it "tends to" disparage.[9] In 1942, the House Committee on Patents marked up a Senate bill and substituted "may" in place of "tends to."[10] Subsequent bills[11] and the enacted legislation contained the "may disparage" standard instead of "tends to disparage." 15 U.S.C. § 1052(a). This is significant. *See Doe v. Chao*, 540 U.S. 614, 622 (2004) (relying on drafting history to interpret statute). "May disparage" is a lower standard than "tends to disparage," which is itself a lower standard than "does disparage."

It is well-established "[i]n common and legal usage" that "'may' reflects possibility, not certainty." *United States v. Arias-Espinosa*, 704 F.3d 616, 619 (9th Cir. 2012); *see also FTC v. Morton Salt Co.*, 334 U.S. 37, 46 (1948) ("may" requires only "reasonable possibility"); *United States v. Lexington Mill & Elevator Co.*, 232 U.S. 399, 411 (1914) (applying ordinary meaning of "may"). Accordingly, it is not

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[9] Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the House Comm. on Patents, 76th Cong., 1st Sess., at 1 (1939) (Section 2(a) contains "tends to disparage" standard); Hearings on H.R. 102, H.R. 5461, S. 895, Before the Subcomm. on Trademarks of the House Comm. on Patents, 77th Cong., 1st Sess., at 1-2 (1941) (Section 2(a) of H.R. 102, which is "identical" to S. 895, contains "tends to disparage" standard); *id.* at 15 (by contrast, H.R. 5461 contains "may disparage" standard).

[10] H.R. Rep. No. 2283, at 2 (1942) (recommending passage of S. 895 with certain amendments, including: "strike out 'tends to' and insert in lieu 'may'" before "disparage").

[11] Hearings on H.R. 82 Before the House Comm. on Patents, 78th Cong., 1st Sess., at 2 (1943); Hearings on H.R. 82 Before the Subcomm. of the Senate Comm. on Patents, 78th Cong., 2d Sess., at 2 (1944).

necessary that the USPTO have evidence that a mark actually disparages in order to be unregistrable, only that it may disparage.

One commentator[12] explained the significance of "may" before "disparage" as follows:

> Section 2(a) provides that registration should be refused when a mark '[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which *may* disparage . . . persons . . . . The statute does not prohibit 'matter which disparages;' rather, it prohibits 'matter which *may* disparage.' The latter is certainly a broader prohibition than the former.

Kimberly A. Pace, *The Washington Redskins Case and The Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 Pepp. L. Rev. 7, 33 (1994). Therefore, "[t]o cancel a mark because it disparages, the mark has to have the potential to disparage the group at the date of its registration." *Id.* at 33 n.174.

B. Intent To Disparage Is Not Required.

The inclusion of "may" also establishes that intent to disparage is not required in order for a mark to be ineligible for registration. *Blackhorse*, 112 F. Supp. 3d at 472.

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[12] The commentator is now the Honorable Kimberly Moore of the Federal Circuit.

Other parts of Section 2(a) also make this point clear. The statute asks whether "matter" in the mark may disparage. "Matter" is the subject and "may disparage" is the verb. But, "matter" is inanimate and cannot possess intent. Likewise, the language shows that the relevant inquiry focuses on the "nature" of the mark, and not the owner's intent. *See* 15 U.S.C. § 1052(a) ("No *trademark* . . . shall be refused registration . . . on account of *its nature* unless *it* . . . [c]onsists of or comprises . . . matter which may disparage . . . .") (emphasis added).

Indeed, if the rule were otherwise, it would be quite difficult for Examining Attorneys to ascertain the intent of registration applicants. *See Negusie v. Holder*, 555 U.S. 511, 527-28 (2009) (Scalia, J., concurring).

C. Evidence Of A "Substantial Composite" Is One Way To Demonstrate That A Mark Contains Matter That "May Disparage," But Is Not The Only Way.

To evaluate whether Tam's marks may disparage, the TTAB considered whether a "substantial composite" of people of Asian descent consider "slants" to be disparaging. *In re Tam*, 108 U.S.P.Q.2d 1305, at *1 (T.T.A.B. 2013); *see also Blackhorse*, 111 U.S.P.Q.2d at *5 (employing substantial composite test). The Federal Circuit has used the "substantial composite" test in the disparagement context, but not through reasoned analysis. In *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 944 (2015), the parties agreed that the Court should employ a

"substantial composite" test and the Court did so for that reason. Subsequently, in *Tam*, the panel cited *Geller* as precedent for the "substantial composite" test. *In re Tam*, 785 F.3d 567, 571 (Fed. Cir. 2015), *vacated by* 808 F.3d 1321 (Fed. Cir. 2015).

There can be no doubt that if a substantial composite of the referenced group view a mark as disparaging, then the mark contains matter that "may disparage." But, while evidence of the views of a "substantial composite" is one way to demonstrate that a mark "may disparage," it should not be assumed to be the *only* way to prove it. *See Flowers v. State*, 220 S.W.3d 919, 922 (Tex. Crim. App. 2007) ("Just as there is more than one way to skin a cat, there is more than one way to prove a prior conviction").

For example, dictionaries, scholarly articles, evidence of usage, and admissions by a party, among other evidence, are all clearly probative to whether a mark contains matter that "may disparage." *See* Fed. R. Evid. 401. And, indeed, the TTAB has relied upon such forms of evidence when applying its "substantial composite" test. *See, e.g., Blackhorse*, 111 U.S.P.Q.2d at *28-29; *Tam*, 108 U.S.P.Q.2d at *1-2 (citing dictionaries); *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, *4-5 (T.T.A.B. 2008) (same); *see also In re Geller*, 751 F.3d at 1358-59 (citing dictionaries). The TTAB has stated that evidence of the general perception of the meaning of a term can "serve to support a finding that the referenced group finds the term to be disparaging." *Blackhorse*, 111 U.S.P.Q.2d at *4 n.15. The TTAB has needlessly complicated things. Such evidence is directly

probative to the "may disparage" question, a question that does not need to be mediated by a "substantial composite" test.

The origin of the "substantial composite" test demonstrates that it is not logical to view it as the sole means of providing that a mark "may disparage." The Federal Circuit's predecessor coined the term "substantial composite" in a case deciding whether a mark contains matter that *actually is* scandalous under Section 2(a). In *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981), the Court stated that "[w]hether or not the mark, including innuendo, is scandalous is to be ascertained from the standpoint of not necessarily a majority, but a substantial composite of the general public." *Id.* at 485; *see also In re Mavety Media Grp., Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). In *Harjo*, the TTAB borrowed "substantial composite" from the "is scandalous" context for use in the "may disparage" context. *Harjo*, 50 U.S.P.Q.2d 1705, *34-36 (T.T.A.B. 1999). Since *Harjo*, the TTAB has continued to use "substantial composite" in the "may disparage" context. T.M.E.P. § 1203.03(b). It is illogical, however, to use an expression relevant to whether a mark contains matter that actually is scandalous as the sole means of assessing whether matter may disparage, since "may disparage" requires only a potential to disparage. *See supra* at 35-37.

For these reasons, this Court's opinion should clarify that satisfying a "substantial composite" test is not the *only* way to demonstrate that a mark contains matter that "may disparage." In short, satisfying the "substantial composite" test is

sufficient, but not necessary, to demonstrate that a mark contains matter that may disparage.

CONCLUSION

For the foregoing reasons, this Court should reverse the judgment of the Federal Circuit.

Respectfully Submitted,

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